

REMARKS

Applicants have reviewed the application in light of the Office Action dated April 20, 2009. Claims 1, 2 and 4–17 remain pending in the application. Applicants have cancelled claim 3. Of the claims remaining in this application, claims 1 and 4-10 stand rejected and claims 2 and 11-17 have been deemed allowable for which applicants extend their thanks. Applicants have added no new matter.

Objection to Claim 3

Claim 3 stands objected to under 37 C.F.R. 1.75(c) as failing to further limit claim 1 from which it depends. In particular, the examiner contends that claim 3 is a redundant form of claim 1, differing only by virtue of the recitation of a “plurality of production devices.”

Applicants have cancelled claim 3, rendering the objection to the claim as now moot.

35 U.S.C. § 101 Rejection of Claims 1 and 3-10.

The examiner has rejected claims 1 and 3-10 under 35 U.S.C. 101 as directed to non-statutory subject matter. In particular, the examiner contends that applicants’ claims 1 and 3-10 do not transform underlying subject matter and therefore do not qualify for patent protection under 35 U.S.C. § 101.

As announced by the Court of Appeals for the Federal Circuit in the recently decided case *In Re Bilski*, 545 F. 3d 943, 953 (Fed Cir. 2008), the appropriate test for determining compliance with 35 U.S.C. §101 is the “machine or transformation” test as elucidated by the U.S. Supreme Court in *Benson*, 409 U.S. 70. In particular, to be eligible for a patent under 35 U.S.C. §101, a process must be tied to a particular machine or transform a particular article to a different

state or thing.

Applicants' claim 1 and 7, and the claims that depend therefrom, constitute statutory subject matter under 35 U.S.C. § 101 because the claims satisfy the "machine" prong of the machine or transformation test set forth by the Court of Appeals for the Federal Circuit in *Biski*.

Claim 1 recites the following steps:

- (a) establishing a plurality of states of the at least one production device, each state corresponding to at least one operation executable by the device;
- (b) storing the states of the at least one production device as corresponding memory objects which upon execution cause the one production device to execute the at least one operation, which results in generation of a scene;
- (c) parameterizing each memory object in accordance with characteristics of the scene that results from execution of that memory object,
- (d) responsive to selection of at least one memory object selected in accordance with the parameterization thereof, executing each selected memory object to cause execution of a corresponding operation by the one television production device to yield at least one scene of interest.

Both of applicants steps (a) and (d) of claim 1 require communication with at least one production device. In step (a), applicants' claim 1 requires communication with the production device to establish its state. In step (d), applicants' claim 1 requires communication with the at least one production device to execute an operation. In this manner, applicants' claim 1 is clearly tied to a machine, namely a television production device.

In this regard, applicants call the examiner's attention to the recent Board of Patent Appeals and Interferences decision of *Ex Parte Andreas Myka et al.* (Appeal No. 2008-3874, May 13, 2009) in which the Board held that method claims that included "communicating information occurring between the master

device and the bonded device” tied the claimed method to a particular machine or apparatus.

As indicated, applicants’ rejected claim 1 implicitly includes the communication of information to and from the at least one television production device. Therefore, applicants’ claim 1 is tied to a particular machine or apparatus, thus rendering the claim, and those that depend therefrom statutory under 35 U.S.C. 101. Applicants request withdrawal of the 35 U.S.C. § 101 rejection of claim 1 and the claims that depend therefrom.

Claim 7 recites the following steps:

- (a) pre-producing the program by controlling at least one of the production devices to establish a scene of the program;
- (b) creating a memory object representing the state the at least one production devices for the at least one scene;
- (c) repeating steps (a) and (b) to establish a plurality of scenes for the program;
- (d) producing the program by recalling the memory objects in a first sequence corresponding to a desired sequence of scenes such that each production devices assumes a state corresponding to the memory object.

Like claim 1, both of applicants’ steps (a) and (d) of claim 7 require communication with at least one production device. In step (a), applicants’ claimed method requires communication with the production device to control it. In step (d), applicants’ claim method requires communication with the at least one production device cause the production device to assume a state corresponding to the memory object.

As with claim 1, applicants contend that claim 7 constitutes statutory subject matter under the rationale of *Ex Parte Andreall Myka et al.* Therefore, applicants request withdrawal of the 35 U.S.C. 101 rejection of claim 7 and the claims that depend therefrom.

Conclusion

In view of the foregoing, applicants solicit entry of this amendment and allowance of the claims. If the Examiner cannot take such action, the Examiner should contact the applicant's attorney at (609) 734-6820 to arrange a mutually convenient date and time for a telephonic interview.

No fees are believed due with regard to this Amendment. Please charge any fee or credit any overpayment to Deposit Account No. **07-0832**.

Respectfully submitted,
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July 20, 2009